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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/347,525	07/06/1999	MASAHARU OKU	103778	3980

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/347,525

Applicant(s)

OKU ET AL.

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on July 15, 2005 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-4, 6, 8 and 13-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the last three lines of claim 1 as amended, reference is newly made to the rubber members being "directly placed" on the support from an end of the extruder feeding portion. It however is not seen that such a limitation was either explicitly or implicitly described in the original disclosure and as such, this is considered to be subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be

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new matter. The only original descriptive support relating to the relationship between the feeding portion of the extruder and the support indicates that the feeding portion is "in the vicinity of the surface of the support," fig. 1 diagrammatically indicating this relationship. It however is not considered that this supports or describes the material being "directly placed" as now claimed, it being noted in particular that it is not even entirely clear what the scope of protection afforded by the reference to "directly placed" is at present (this to be treated below in a 35 USC 112, second paragraph rejection). In other words, "directly placed" could be read as defining or requiring that the material is placed on the surface of the support from the die substantially without any space therebetween, i.e. without any unsupported length of material between the die and support. It is submitted however that the original disclosure would not support such a limitation. Alternatively, "directly placed" could be read as defining what is happening to the strip between the time it is extruded and when it is placed (rather than necessarily a spatial relationship), i.e. it could be read to mean that the material is not for example cut and rolled up prior to placement (which would be "indirect placement"), such an interpretation however also lacking descriptive support in the original disclosure.

Along somewhat similar lines, it is not clear where original descriptive support exists for the "direct" feeding referred to at lines 18-21 of claim 1, this therefore also considered to be subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter.

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4. Claims 1-4, 6, 8 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For the reasons detailed above, it is not clear how the term "directly" as added to various parts of claim 1 is to be interpreted, especially as this terminology was not used in the original disclosure, the scope of the claims therefore being considered indefinite.

5. Claims 1-4, 6, 8 and 13-15 are rejected under 35 U.S.C. 103(a) as obvious over Deist (US 3,170,499) taken in view of Hanson (US 2,849,049), Okada (US 6,039,826), Laurent (US 4,963,207 - newly cited) and at least one of [Moller (US 5,148,943 - of record; newly applied) and Hatfield (US 6,277,314 - newly cited)].

Deist, Hanson and Okada are applied herein for the same reasons of record in the examiner's answer and Board of Appeals affirmance (dated May 16, 2005), the comments made in the examiner's answer and Board of Appeals decision being expressly incorporated by reference herein.

As to the new limitations in claim 1; with respect to limitation (a), Deist would suggest feeding each material from an individual feeding device (e.g. 75, 76, 77 in fig. 2) to a feed control device (e.g. 81, 82, 83, 85) before being fed to, in the case of fig. 2, the mill rolls 71/72. Further, as noted in detail in the prior office action and the Board of Appeals decision, Deist also specifically teaches that "feed to the extruder means would be controlled as described with reference to feeding the mills" (col. 7, lines 34-40). As such, Deist is considered to suggest feeding consistent with new part "(a)" of claim 1 but does not expressly describe that the feed to the extruder itself is through a hopper. In

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the feeding of materials to an extruder, including the feeding of a controlled quantity of different materials, it is extremely well known that the materials are fed into the extruder *via a hopper* - Moller (e.g. note common hopper 30) and Hatfield (note hopper "64" in fig. 4) are exemplary, these references further being directed to feeding a controlled feed of different materials to the extruder through the hopper. To feed the extruder In Deist through an inlet hopper would therefore have been obvious and lead to only the expected results.

As to new part "(b)" of claim 1, as already noted in prior actions, Deist suggests application of the ribbon using for example a system as in Hanson, it being noted that Hanson teaches (e.g. fig. 1) providing the extruder adjacent the winding support without any intermediate activity on the strip (e.g. cutting), it being considered that this can be considered consistent with being "directly placed" for reasons already noted within the 112 rejections above. Alternatively, if this limitation is read to require some closer spatial relationship of the extruder die to the support, it is noted that in the art of winding extruded strips in building tires, Laurent teaches that it is desirable to provide the extruder die close to the support surface, this

"thereby assuring great precision in the building of the tire, while being independent to a very large extent of the mechanical strength properties of the rubber in the unvulcanized state. This makes possible the use of compounds different from those heretofore used in the manufacture of tires since these compounds are not mechanically stressed by the laying process used" (col. 4, lines 6-14 of Laurent).

In light of this teaching, it is considered that it would have been obvious to directly place the strip on the surface. It should also be noted that the spatial relationship between the die and support suggested by Laurent is apparently entirely

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consistent with that originally described by applicant in the original disclosure, note being taken of the fact that JP 7-94155 (which corresponds to Laurent) is described at page 2, lines 7-11 of the specification using the same language ("in the vicinity...") used to describe the inventive device (note page 8, lines 6-8).

6. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection added to address the newly claimed features.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
September 20, 2005